

Serial No.: 10/099,785
Amendment dated August 29, 2005
Response to Office Action mailed March 28, 2005

REMARKS/ARGUMENTS

The Office Action of March 28, 2005 has been carefully reviewed and these remarks are responsive thereto.

Claims 1-15, 17-18, and 24-35 are pending. Claims 16 and 19-23 are cancelled. Claims 1-2, 17-18 and 24-30 were rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite. Claims 1, 4-16 and 19-27 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,350,411 to Ryan ("Ryan"). In the alternative, claims 1, 4-16 and 19-27 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Ryan. Claims 29-30 were deemed allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, ¶ 2. Claims 31-35 were deemed allowable.

As an initial matter, Applicants would like to express their appreciation for the indication of allowable subject matter. The Applicants believe there is additional allowable matter and respectfully requests reconsideration in light of the above amendments and the following remarks.

Amendment to the Specification

The specification has been amended to recite the serial number of the referenced application in two different paragraphs, as suggested by the Office Action. Entry of this change is respectfully requested.

Cancelled Claims

Claims 16 and 19-23 have been cancelled, thus mooted the rejection of these claims.

Amended Claims

Independent claim 1 has been amended to recite "building a downlink definition." Support is at least found in paragraph 56, thus no new matter has been added. Claim 1 has also been amended to remove reference to "steps" so as to avoid any misinterpretation that the claims are written in step-plus-function language.

Claims 2-3 have been revised to clarify their connection to claim 1. In addition claims 2-11 have been amended to correspond to the changes in claim 1. No new matter has been added.

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Independent claim 12 has been amended to recite "building a downlink definition." Support is at least found in paragraph 56, thus no new matter has been added. Claim 12 has also been amended to remove reference to "steps" so as to prevent the interpretation that the claims are written in step-plus-function language.

Claims 13-15 have been amended to correspond to the amended claim 12.

Claims 17 has been rewritten in independent form. Claim 18 have been amended to clarify its dependence to claim 17.

Independent claim 24 has been amended to clarify its scope. As the microcontroller and memory was inherently part of the telemetry unit, Applicants respectfully submit that the scope of claim 24 has not been changed by this amendment but instead the amendments simply clarify the intended scope of the claim. Dependent claims 25 and 28 have been amended to correspond to the change to claim 24.

Claims 32 and 35 have been amended to correct a minor typographical error.

Rejection under 35 U.S.C. § 112, ¶ 2

Claims 2-3, 17-18 and 24-30 were rejected under 35 U.S.C. § 112, ¶ 2 for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

Before discussing the rejection, the Applicants would like to comment on several aspects of the invention to ensure there is no confusion. While the protocol driver refers to software, which may be provided as firmware, the transmit driver and receive driver are not limited to software but instead may represent a combination of hardware and software, where the software may be provided as firmware. Thus, the transmit driver and the receive driver may be referred to as an amalgam of software and hardware that performs the intended function. (See Specification as filed, ¶ 61).

Turning to claim 2-3 and 17-18, Applicants have amended the claims to better explain the connection to the claims from which they depend. Therefore, Applicants believe the claims 2-3 and 17-18 now particularly point out and distinctly claim the subject matter regarded as the invention.

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Looking at claims 24-30, independent claim 24 has been amended to clarify its scope. The applicants respectfully submit that claims 24-30 now particularly point out and distinctly claim the subject matter regarded as the invention.

The Office Action also indicated it was not clear how a "driver" could receive a signal. The Applicants respectfully submit that software regularly receives signals (e.g. inputs) and therefore believe it is acceptable for software to receive a signal.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

Rejection in view of Ryan

Claims 1, 4-16, and 19-27 were rejected in view of Ryan, either under 35 U.S.C. § 102(b) as being anticipated or in the alternative, under 35 U.S.C. § 103(a) as being obvious.

As noted above, claim 1 now recites "building a downlink definition" and "using the downlink definition to configure a transmit driver." Applicants respectfully submit that Ryan fails to disclose, suggest or teach such a feature. Therefore, Ryan fails to anticipate claim 1. In addition, as Ryan does not disclose all the limitations of claim 1, Ryan fails to support a *prima facie* case of obviousness with regard to claim 1. See MPEP 706.02(j) ("To establish a *prima facie* case of obviousness, three basic criteria must be met. ... [Third], the prior art reference[s] ... must teach or suggest all the claim limitations"). No other reference has been suggested as combinable with Ryan, thus the references of record do not support a *prima facie* case of obviousness.

Claims 4-11 depend from claim 1 and are not anticipated or rendered obvious in light of Ryan for at least the above reasons and for the additional limitations recited therein.

Regarding the rejection of dependent claims 9-11, Applicants respectfully submit the Office Action has failed to set forth a *prima facie* case of obviousness. As an initial matter, the Office Action does not suggest these limitations are disclosed in Ryan. Therefore, the Office Actions basically admits these limitations are not disclosed in Ryan. Thus, Ryan cannot be said to anticipate claims 9-11.

Regarding the alternative obviousness rejection, Applicants respectfully submit that the Examiner's subjective belief regarding to obviousness of a limitation does not support a *prima*

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facie case of obviousness. Instead, all the limitations must be disclosed, taught or suggested by the references of record. See MPEP 706.02(j) ("To establish a *prima facie* case of obviousness, three basic criteria must be met. ... [Third], the prior art reference[s] ... must teach or suggest all the claim limitations"). In addition, even if one assumes that the Office Action is correct, and the Applicants disagree with the reasoning provided in the Office Action, the Office Action still does not support a *prima facie* case of obviousness because the question is whether the limitations in claims 9-11 would have been obvious at the time the application was filed. The Office Action has provided no support for such a contention and, therefore, has not made a *prima facie* case of obviousness with regard to claims 9-11.

Regarding independent claim 12, it now recites "building a downlink definition" and "using the downlink definition to configure a transmit driver" as in claim 1. For at least the reasons discussed with regard to claim 1, Ryan fails to anticipate or make obvious claim 12. Claims 13-15 depend from claim 12 and are not anticipated or rendered obvious for at least same reasons as claim 12 and for the additional limitations recited therein.

Looking at independent claim 24, it now recites "a configurable transmit driver, the transmit driver configured to receive a configuration signal from the protocol driver and to generate a transmit signal having parameters specified by the configuration signal received from the protocol driver." Applicants respectfully submit that Ryan fails to disclose, suggest or teach a transmit driver as recited in claim 24. As Ryan does not disclose such a limitation, Ryan cannot anticipate claim 24. In addition, as Ryan does not disclose, suggest or teach such a limitation and no other reference has been provided to disclose such a limitation, Ryan fails to support a *prima facie* case of obviousness for independent claim 24.

Claims 25-27 depend from claim 24 and are not anticipated or rendered obvious for at least the above reasons and for the additional limitations recited therein.

Accordingly, withdrawal of this rejection under either ground is respectfully requested.

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CONCLUSION

All rejections and objections having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,
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Dated: August 29, 2005

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